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EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/739,816

Applicant(s)

MALIK, DALE W.

Examiner

Jeffrey R. Swearingen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 2/28/2006 have been fully considered but they are not persuasive.
2. Applicant argued Mertama failed to disclose receiving an email message at the source email server, wherein the email message is separate from the predetermined set of email messages stored on the source email server, wherein said email message has a destination email address in a first field, a code in a second field and an instruction in a third field, wherein said destination email address corresponds to a subscriber account on the remote email network. Applicant argued that Mertama's message for performing mail manipulation was not an "email message" and alleged it was an IMAP command. As per column 6, lines 9-40, IMAP was used *in an electronic mail service implementation* (lines 22-23) to transmit a message with commands to manipulate "electronic mail messages". The fact that a command was transmitted via an electronic mail protocol dictates that said command was an "email message".
3. Applicant repeated the argument addressed in paragraph 2 with regard to claim 23.
4. Applicant repeated the argument addressed in paragraph 2 with regard to claim 38.
5. Applicant repeated the argument addressed in paragraph 2 with regard to claim 44.
6. Applicant repeated the argument addressed in paragraph 2 with regard to claim 49.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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8. Claims 1-12, 15-29, 32-42, and 44-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Mertama et al. (U.S. Patent No. 6,629,130).

9. In regard to claim 1, Mertama disclosed *receiving an email message at the source email server, wherein the email message is separate from the predetermined set of email messages stored on the source email server, wherein said email message has a destination email address in a first field, a code in a second field and an instruction in a third field, wherein said destination email address corresponds to a subscriber account on the remote email network; checking a database to determine a permission for the destination email address; and applying the instruction to the predetermined set of email messages if the permission is granted.* Mertama sent a second message comprising information about processing a first electronic mail message. The processing was performed on the first electronic mail message by the server based upon the command in the second message. Column 2, lines 5-31. A database was used to store appropriate information about the structure of email messages. Column 2, lines 35-40. The attributes of the messages in the database comprise the *permissions for the destination email address*. Column 2, lines 54-65. See further column 4, lines 53-65; column 5, lines 2-21; column 5, line 35 – column 6, line 8; column 6, lines 20-56.

10. In regard to claim 2, Mertama is applied as in claim 1. Mertama further disclosed *populating the database with subscriber email addresses corresponding to subscriber accounts authorized to remotely manage email messages.* This is included in the database of the electronic mail server and the attributes relating to the content of said structural parts, as in column 2, lines 34-38.

11. In regard to claim 3, Mertama is applied as in claim 2. Mertama further disclosed *populating the database with a device type associated with each subscriber email address, and checking the database for the device type corresponding to the destination email address, determining if the device type is compatible with the instruction, and modifying the instruction according to the device type.* This was shown in the determination of the conversion availability based upon available resources as shown in column 7, lines 4-29.

12. In regard to claim 4, Mertama is applied as in claim 2. Mertama further disclosed *receiving a second email message at the source email server, wherein said second email message comprises a local*

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subscriber's identification in a message sender field and wherein said second email message comprises at least one subscriber email address in a message body field. The presence of sender and recipient information in an email message is inherent to receiving said email message.

13. In regard to claim 5, Mertama is applied as in claim 1. Mertama further disclosed *the code comprises a predetermined data string and wherein the second field is a message subject field.* The *predetermined data string* was an IMAP parameter string as taught in column 6, lines 41-56. The additional parameters included the *message subject field*. For an example, see column 6, lines 20-40, where a FETCH command (*predetermined data string*) was accompanied by a command argument such as BODY, which denoted a structure of the message. The *message subject field* is a structure of the message fitting the definition of column 6, line 31 and 34-40.

14. In regard to claim 6, Mertama is applied as in claim 1. Mertama further disclosed *the first field is a message sender field.* This was included in the IMAP parameter string illustrated in column 6, lines 41-56.

15. In regard to claim 7, Mertama is applied as in claim 1. Mertama further disclosed *the code comprises a predetermined data string and wherein the second field comprises a message addressee field.* This was included in the IMAP parameter string illustrated in column 6, lines 41-56.

16. In regard to claim 8, Mertama is applied as in claim 7. Mertama further disclosed *the predetermined string corresponds to an email account on the source server.* The IMAP parameter string illustrates the usage of an email field in column 6, line 53.

17. In regard to claim 9, Mertama is applied as in claim 1. Mertama further disclosed *sending an information message to the destination email address if the permission is denied.* See column 7, lines 20-24, which denotes the messages BAD and NO denoting the inability to perform the necessary email conversion.

18. In regard to claim 10, Mertama is applied as in claim 1. Mertama further disclosed *the instruction is a retrieve command, and wherein in response to said instruction, sending the predetermined set of email messages to the destination email address.* See the IMAP FETCH command in column 6, lines 20-40.

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19. In regard to claim 11, Mertama is applied as in claim 1. Mertama further disclosed *the instruction comprises a command and a criteria, and wherein in response to said instruction, searching a mailbox associated with the subscriber account to select the predetermined set of email messages according to the criteria*. The parameters and command arguments denoting the structure of the email messages taught this in column 6, lines 20-56.

20. In regard to claim 12, Mertama is applied as in claim 11. Mertama further disclosed *the command is a retrieve command*. See the FETCH command of column 6.

21. In regard to claim 15, Mertama is applied as in claim 11. Mertama further disclosed *the criteria comprises a sender's name string*. The parameters and command arguments denoting the structure of the email messages taught this in column 6, lines 20-56.

22. In regard to claim 16, Mertama is applied as in claim 11. Mertama further disclosed *the criteria comprises a subject string*. The parameters and command arguments denoting the structure of the email messages taught this in column 6, lines 20-56.

23. In regard to claim 17, Mertama is applied as in claim 11. Mertama further disclosed *the criteria comprises a date string*. The parameters and command arguments denoting the structure of the email messages taught this in column 6, lines 20-56.

24. In regard to claim 18, Mertama is applied as in claim 11. Mertama further disclosed *the criteria comprises a Boolean operation and a plurality of date strings*. The parameters and command arguments denoting the structure of the email messages taught this in column 6, lines 20-56.

25. In regard to claim 19, Mertama is applied as in claim 11. Mertama further disclosed *the criteria comprises a subject string and a sender's name string*. The parameters and command arguments denoting the structure of the email messages taught this in column 6, lines 20-56.

26. In regard to claim 20, Mertama is applied as in claim 11. Mertama further disclosed *the criteria comprises a recipient name string*. The parameters and command arguments denoting the structure of the email messages taught this in column 6, lines 20-56.

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27. In regard to claim 21, Mertama is applied as in claim 1. Mertama further disclosed *the third field comprises a message body field*. The BODY structure of the email was explicitly stated in column 6, line 29.

28. In regard to claim 22, Mertama is applied as in claim 1. Mertama further disclosed *the instruction comprises a null string and performing a default action on the predetermined set of email messages*.

Column 5, lines 7-13 disclosed sending the email without conversion, or *performing a default action*.

29. Claim 23 is substantially the same as claims 1 and 2.

30. Claim 24 is substantially the same as claim 9.

31. Claim 25 is substantially the same as claim 3.

32. Claim 26 is substantially the same as claim 4.

33. Claim 27 is substantially the same as claim 10.

34. Claim 28 is substantially the same as claim 11.

35. Claim 29 is substantially the same as claim 12.

36. Claim 32 is substantially the same as claim 15.

37. Claim 33 is substantially the same as claim 16.

38. Claim 34 is substantially the same as claim 17.

39. Claim 35 is substantially the same as claim 18.

40. Claim 36 is substantially the same as claim 19.

41. Claim 37 is substantially the same as claim 20.

42. Claim 38 is substantially the same as claims 1 and 2.

43. In regard to claim 39, Mertama is applied as in claim 38. The presence of a message subject field is inherent to Mertama, as illustrated in the description of the "message structure" in column 6, lines 20-40.

44. In regard to claim 40, Mertama is applied as in claim 38. The presence of a message addressee field (recipient) is inherent to Mertama, as illustrated in the description of the "message structure" in column 6, lines 20-40.

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45. In regard to claim 41, Mertama is applied as in claim 38. Mertama further disclosed *the second email message further comprises an instruction in a second predetermined field, and wherein said method further comprises the step of processing said instruction to manipulate the first email message according to the instruction.* See column 2, lines 10-18.

46. In regard to claim 42, Mertama is applied as in claim 41. The presence of a message body field is inherent to Mertama, as illustrated in the description of the "message structure" in column 6, lines 20-40.

47. Claim 44 is substantially the same as claim 1.

48. Claim 45 is substantially the same as claim 39.

49. Claim 46 is substantially the same as claim 21.

50. Claim 47 is substantially the same as claim 41.

51. Claim 48 is substantially the same as claim 2.

52. Claim 49 is substantially the same as claims 1 and 2.

Claim Rejections - 35 USC § 103

53. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

54. Claims 13-14, 30-31 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mertama in view of Crispin (RFC 1730: Internet Message Access Protocol – Version 4, December 1994).

55. In regard to claim 13, Mertama is applied as in claim 11. Mertama disclosed the use of the IMAP4 protocol, but failed to explicitly disclose the use of a delete command. Crispin, in the standard for the IMAP4 protocol, disclosed that such a delete command was present in IMAP4 in section 6.3.4. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use any IMAP4

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command available with the Mertama invention, including a delete command, since Mertama explicitly disclosed the use of a MIME-compatible IMAP4 electronic mail protocol in column 6, lines 8-11.

56. In regard to claim 14, Mertama is applied as in claim 11. Mertama disclosed the use of a retrieve command in the rejection of claim 12. The rejection of claim 13 disclosed the ability for Mertama to support a delete command.

57. Claim 30 is substantially the same as claim 13.

58. Claim 31 is substantially the same as claim 14.

59. In regard to claim 43, Mertama is applied as in claim 38. As previously shown in claim 13, the ability to delete an email was an obvious variant on Mertama. Therefore it would have been obvious to one of ordinary skill in the art to delete a message as taught in Crispin on the Mertama invention for the purpose of conserving unused resources.

Conclusion

60. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

61. Graham, Jay. "Enterprise Wide Electronic Mail using IMAP." Proceedings of the 27th annual ACM SIGUCCS Conference on User Services: Mile High Expectations. ACM Press. November 1999. 83-85.

62. Berchtold, Stefan et al. "SaveMe: A System for Archiving Electronic Documents Using Messaging Groupware." Proceedings of the International Joint Conference on Work Activities Coordination and Collaboration. March 1999. ACM Press. 167-176.

63. Hoffman, Paul. "Putting it Together: Designs on Internet Mail." netWorker. Volume 2, Issue 1. March 1998. pp 19-23.

64. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date


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of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason Cardone
Supervisory Patent Examiner
Art Unit 2145